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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/669,426 | 09/25/2000 | Takeshi Igarashi | 205701 | 4028 |

7590 08/14/2003

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| EXAMINER | |
| NGUYEN, CAM N | |
| ART UNIT | PAPER NUMBER |
| 1754 | |

DATE MAILED: 08/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/669,426 | Applicant(s) Igarashi et al. |  |
| Examiner Cam Nguyen | Art Unit 1754 |  | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>three</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>5/13/03 (an RCE application/amendment/response)</u> . | | | |
| 2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final. | | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-10 and 13</u> is/are pending in the application. | | | |
| 4a) Of the above, claim(s) _____ is/are withdrawn from consideration. | | | |
| 5) <input checked="" type="checkbox"/> Claim(s) <u>4 and 6-9</u> is/are allowed. | | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1-3, 5, and 10</u> is/are rejected. | | | |
| 7) <input checked="" type="checkbox"/> Claim(s) <u>1, 2, 4, 7, 8, 10, and 13</u> is/are objected to. | | | |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. | | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | |
| 13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | |
| a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received. | | | |
| 14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | | |
| 15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | |
| Attachment(s) | | | |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | | | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | | |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>7</u> | | | |
| 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ | | | |
| 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | | | |
| 6) <input type="checkbox"/> Other: _____ | | | |

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DETAILED ACTION

Status of RCE Application

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 5/13/03 has been entered.

2. Applicants' remarks and amendments, filed on 5/13/03, have been carefully considered. Claims 1-4 & 6-10 have been amended. New claim 13 has been added.
Claims 1-10 & 13 are now pending in this application.

Claim Objections

3. Claims 1-2, 4, 7-8, 10, & 13 are objected to because of the following informalities:
 - A. In claim 1, line 2, "which" should be deleted.
 - B. In claim 1, line 2-3, "and form for the hydrocyanic acid synthesis catalyst and" should be deleted. Recitation of "form" is unnecessary since the term "an iron source" in the claim is clear and understood.
 - C. In claim 2, line 2, "said form" should be --said iron source--.

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- D. In claim 4, line 2, "which" should be deleted.
- E. In claim 4, line 2-3, same as in B.
- F. In claim 4, line 4, --wherein-- should be inserted before "the oxidative atmosphere".
- G. In claim 4, line 4, "being" should be --is--.
- H. In claim 7, line 2-3, same as in B.
- I. In claim 7, line 4, a comma -- , -- should be inserted before "wherein".
- J. In claim 8, line 2-3, same as in B.
- K. In claim 8, line 4, a comma -- , -- should be inserted before "wherein".
- L. In claim 10, line 2, "and form and" should be deleted.
- M. In claim 13, "are utilized" should be changed to --of exposure are carried out--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102(e)

- 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- 5. Claims 1-3, 5, & 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohmi, "hereinafter Ohmi '424", (U.S Pat. 5,817,424).

Ohmi '424 discloses a method of forming a passive oxide film on the surface of the steel pipe (or iron pipe) including the steps of subjecting the interior of a stainless steel pipe to a heat treatment at a temperature of 500°C and for a period of 1 hour in an atmosphere of a gas containing hydrogen and oxygen, with a hydrogen concentration of 10% and oxygen concentration of 100 ppb, forming a passive oxide film on the steel pipe (see col. 8, ln 11-20). The passive oxide film on the steel pipe obtained is further subjected to another heat treatment at a temperature of 500°C with a gas containing hydrogen and oxygen, with hydrogen concentration of 10% and oxygen concentration of 1 ppm, supplied to the interior of the pipe for a period of 1 hour, and the thermal oxidation treatment was conducted (see col. 8, ln 21-29).

Recitation of "a method of producing a hydrocyanic acid synthesis catalyst" in the preamble is noted. It is considered the process disclosed by the reference for forming the passive oxide film on the steel pipe surface is the same as the claimed process because both applicants and the reference teach to conduct the process in the same manner.

With respect to the claimed hydrogen gas concentration (in claim 5), the claimed hydrogen gas concentration is met by the teaching of the reference since the disclosed range falls within the claimed range (see Ohmi '424 at col. 8, ln 11-20).

Allowable Subject Matter

6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not disclose or fairly suggest a method for producing a hydrocyanic acid synthesis catalyst requiring sequentially exposing the iron surface to oxidative and reductive atmospheres for at least 10 cycles.

Response to Applicants' Arguments

7. Applicants' amendment/response filed on 5/13/03 have been considered, but not deemed persuasive for the following the reasons.

Applicants urged, that "the Ohmi process does not sequentially expose any iron surface to oxidative and reductive atmospheres. Ohmi discloses subjecting stainless steel to a heat treatment with a gas containing hydrogen and oxygen together at selected concentrations so as to form a passive oxide film based on chromium oxide..." This is noted, but not found persuasive because applicants' independent claim 1 simply requires "selecting an iron source having an iron surface then sequentially exposing the iron surface to oxidative and reductive atmospheres", which simply means "a process for treating the iron surface". While Ohmi teaches to form a passive oxide film layer on the surface of the steel pipe (or iron pipe), the oxide film layer formed on the surface of the steel pipe as disclosed by the reference is not being excluded from

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the claimed process. The fact is that Ohmi clearly teaches exposing the same iron source to the same treatment conditions, thus provides for the same process.

It is the Examiner's position to conclude that the claimed process is the same as the reference's process, the rejection is therefore maintained.

8. This is an RCE of applicant's earlier Application No. 09/669,426. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Conclusion

9. Claims 1-10 & 13 are pending. Claims 1-2, 4, 7-8, 10, & 13 are objected. Claims 1-3, 5, & 10 are rejected. Claims 4 & 6-9 are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Cam Nguyen

Cam Nguyen

Patent Examiner

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Nguyen/cnn *Cen*

August 12, 2003